

Remarks

This Amendment and Response and the following remarks are intended to fully respond to the Final Office Action mailed May 30, 2008. In that Office Action, claims 1-14 and 63-65 were examined and all were rejected. Specifically, claims 1-14 and 63-65 were rejected under 35 U.S.C. § 112, second paragraph, as being “indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” *Office Action, 05/30/2008, at 2*. Claims 1-3, 5, 7-9, 11-12, 14, and 63-64 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. App. Pub. No. 2004/0226002 to Larcheveque et al. (“Larcheveque”). Claims 4, 6, 10, and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Larcheveque in view of “Official Notice.” Reconsideration of these rejections, as they might apply to the original and amended claims in view of these remarks, is respectfully requested.

In this Amendment and Response, claims 1-3, 9, 14, and 63-64 have been amended. The Specification supports these claim amendments. *See, e.g., Specification (at [0007], [0040-0044], FIG. 3).*¹ Claim 7 is cancelled without prejudice. Claims 15-62 and 66-83 remain cancelled. Therefore, claims 1-6, 8-14, and 63-65 remain present for examination.

Statement of Substance of Examiner Interview dated October 28, 2008

The Applicant would like to thank Examiner Le Nguyen for her time in holding a telephone interview with the Applicant’s representatives, namely, Sung Kim, Timothy Scull, and Elizabeth Reagan, on October 28, 2008. During the interview, the following

¹ The citations to the Specification are offered by way of example only. Additional citations exist. *See Specification.*

items were discussed: (1) 35 U.S.C. § 102(e) rejections; (2) 35 U.S.C. § 103(a) rejections; (3) 35 U.S.C. § 112 rejections; and (4) cited art, i.e., U.S. Pat. App. Pub. No. 2004-0226002 to Larcheveque et al. No agreement was reached. Again, the Applicant would like to thank Examiner Nguyen for her time.

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35 U.S.C. § 112, Second Paragraph, Rejections: Claim 7

The Office Action on p. 2 indicates that claims 1-14 and 63-65 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. However, only claim 7 is discussed, in which the Examiner stated, “In regards to claim 7, it is unclear what is meant by ‘primarily data’ since the limits of what constitutes as ‘primarily’ is not described.” *Office Action, 05/30/2008, at 2*. Therefore, Applicant assumes that only the rejection of claim 7 was intended. If this assumption is incorrect, the Applicant respectfully requests clarification. With respect to claim 7, in the interest only of expediting the prosecution of this application to allowance, claim 7 has been cancelled herein without prejudice. The Applicant reserves the right to file this, or similar claim(s), in future continuation applications, if any.

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35 U.S.C. § 102(e) Rejections: Claims 1-3, 5, 7-9, 11, 12, 14, and 63-64

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Claims 1-3, 5, 7-9, 11, 12, 14, and 63-64 stand rejected under 35 U.S.C. §102(e) as anticipated by Larcheveque. The Applicant respectfully disagrees. To anticipate under 35 U.S.C. §102(e), a single prior art reference must show each and every limitation of the claimed invention. *See, e.g., Massey v. Del Lab.*, 118 F.3d 1568, 1573 (Fed. Cir. 1997). Larcheveque fails to teach each and every aspect of the claim elements.

For example, with respect to claims 1 and 63, Larcheveque fails to teach or suggest, at a minimum:

...
discovering, without user interaction, a solution, the solution
defining one or more available actions for entering data into one or more
operable fields of an electronic form associated with the data file;
deploying, without user interaction, the solution;
displaying, to the user, by opening the data file with the solution,
the electronic form having the one or more operable fields;
receiving input from the user to set the context of a selected
operable field;
in response to the context set by the user, displaying to the user the
one or more available actions for entering data into the selected operable
field of the electronic form; and
after displaying the one or more available actions, enabling the
user to enter data, based on the one or more available actions, into the
selected operable field of the electronic form.

See claim 1, supra (as amended).

...
means for discovering and deploying, without user interaction, a
solution governing the data file, wherein the solution defines one or more
available actions for entering data into one or more operable fields of an
electronic form associated with the data file;
means for displaying the electronic form representing a product of
the solution and the data file, wherein the electronic form comprises the
one or more operable fields;
means for receiving input from a user to set the context of a
selected operable field;
means for displaying, in response to the context set by the user,
one or more available actions to the user for entering data into the selected
operable field of the electronic form;
means for, after displaying the one or more available actions,
enabling the user to enter data, based on the one or more available actions,
into the selected operable field of the electronic form. . . .

See claim 63, supra (as amended).

In rejecting these claims, the Examiner relied upon Larcheveque, paragraph [0092]. *Office Action, 05/30/2008, at p. 3.* The Examiner argued that “Larcheveque

teaches deploying or discovering a solution via the availability of one or more actions to the user during the validation step to confirm input data (par. [0097])”. *Office Action*, 05/30/2008, at p. 8. The Applicant respectfully disagrees. Larcheveque at paragraphs [0092] and [0097] discusses validation of data *already* entered into a form field: “Here, the expense report 201 electronic form shows that *the data entered* into the report date data-entry field 202 is invalid with a dialog box 602. This dialog box can pop up automatically or after the user requests information Once the dialog box is dismissed, the real-time validation tool 122 *rolls back the invalid entry* and enables the user to continue editing the electronic form. This editing can include *re-inputting data* into the data-entry field (block 320), or editing another data-entry field. Alternatively, the real-time validation tool 122 *leaves the error in the document*, but will not allow the user to continue editing the document without first correcting the error.” *Larcheveque (at [0092] & [0097]) (emphasis added); see also Larcheveque at FIG. 3.* For convenience and completeness, the aforementioned portions of Larcheveque relied upon in making out the rejection are excerpted below:

FIG. 6 shows another example. Here, the expense report 201 electronic form shows that the data entered into the report date data-entry field 202 is invalid with a dialog box 602. This dialog box can pop up automatically or after the user requests information, such as by moving his mouse pointer onto the report date data-entry field 202. Also in this example, FIG. 6 shows an option for the user to gain additional information about the error and/or data-entry field by selecting an auxiliary information option 604 entitled "full error description". If the user selects this option, the system 100 will present the user with more information about the error and/or what the data-entry field requires (not shown). The real-time validation tool 122 allows the user to select additional information through a tool-tips icon, right-clicking on the data-entry field, and menu commands for navigating errors. It can also present additional information for multiple errors at once, such as through a list presenting information about every error in an electronic form.

Larcheveque, paragraph [0092].

5 For modal errors, however, the real-time validation tool 122 presents a dialog (block 318). The user then can dismiss the dialog. Once the dialog is dismissed, the real-time validation tool 122 rolls back the invalid entry and enables the user to continue editing the electronic form. This editing can include re-inputting data into the data-entry field (block 320), or editing another data-entry field. Alternatively, the real-time validation tool 122 leaves the error in the document, but will not allow the user to
10 continue editing the document without first correcting the error.

Larcheveque, paragraph [0097].

The above-excerpted portions describe validation that occurs *after* data is entered
15 and/or describe requesting “information” related thereto through viewing a “dialog box”:
“This dialog box can pop up automatically or after the user requests *information . . . FIG. 6* shows an option for the user to gain additional information *about the error and/or data-entry field by selecting an auxiliary information option 604 entitled ‘full error description’.*” Larcheveque at [0092] (*emphasis added*). Indeed, FIG. 3 of Larcheveque
20 illustrates that an electronic form with data-entry fields is displayed (302), and the user is enabled to input data into a data-entry field (304). Data is received (306) and then validated (308-320). Larcheveque at FIG. 3. Larcheveque thus neither discloses nor teaches, at a minimum, “displaying. . . by *opening the data file with the solution*, the electronic form . . . *in response to the context set by the user*, displaying to the user the
25 one or more available *actions for entering data,*” see claim 1 (as amended) (*emphasis added*), and then enabling the user to enter data, *based on the one or more available actions*:

- . . . opening the data file with the solution . . .
- receiving input from the user to set the context of a selected
30 operable field;

- in response to the context set by the user, displaying to the user the one or more available actions for entering data into the selected operable field of the electronic form; and
- after displaying the one or more available actions, enabling the user to enter data, based on the one or more available actions, into the selected operable field of the electronic form.

Claim 1, supra (as amended) (excerpted).

- means for displaying the electronic form representing a product of the solution and the data file . . .
- means for receiving input from a user to set the context of a selected operable field;
- means for displaying, in response to the context set by the user, one or more available actions to the user for entering data into the selected operable field of the electronic form;
- means for, after displaying the one or more available actions, enabling the user to enter data, based on the one or more available actions, into the selected operable field of the electronic form

Claim 63, supra (as amended) (excerpted).

For at least these reasons, claims 1 and 63 are not anticipated by Larcheveque and withdrawal of the rejections under 35 U.S.C. §102(e) is respectfully requested. Because claims 2-6, 8-13, and 64-65 depend on the allowable base claims 1 and 63, these claims are also patentable, and allowance of these claims is respectfully requested. Further, claim 14 is also patentable because it recites language similar to claim 1. *See claim 14, supra (as amended).* Allowance of claim 14 is therefore also respectfully requested. While the Applicant has made amendments to the claims as noted, the Applicant notes that the amendments to claims 1 and 63, and the claims dependent thereon, are made in the interest only of forwarding the prosecution of this application to allowance and do not necessarily indicate agreement with the Examiner's rejections. These claim amendments are therefore made without prejudice.

35 U.S.C. §103(a) Rejections and Official Notice: Claims 4, 6, 10, 13, and 65

Claims 4, 6, 10, 13, and 65 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Larcheveque in view of Official Notice. The Applicant respectfully disagrees. The Applicant respectfully traverses the § 103(a) rejections because the Examiner has failed to state a prima facie case of obviousness. Under 35 U.S.C. §103(c)(1), a § 103 rejection is improper where the cited art and the subject application were owned by, or subject to an obligation of assignment to, the same person at the time of invention.

Larcheveque and the present application were commonly owned by, or subject to an obligation of assignment to, Microsoft Corporation at the time the claimed invention was made. 35 U.S.C. § 103(c)(1) states: “Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.” *MPEP § 2146*.

The Applicant asserts and declares that U.S. Pat. App. Pub. No. 2004/0226002 to Larcheveque et al. and the subject application (Ser. No. 10/609,238) were commonly owned by, or subject to an obligation of assignment to, Microsoft Corporation, at the time the claimed invention was made. *See Assignment (Ser. No. 10/609,238) (recorded 06/27/2003, Microsoft) and Assignment (Ser. No. 10/723,730) (recorded 11/25/03, Microsoft)*. Accordingly, Larcheveque is disqualified as a prior art reference against the

subject application under 35 U.S.C. §103(c)(1) and withdrawal of Larcheveque is respectfully requested.

A separate declaration is not required to establish common ownership/assignment.

The Examiner is respectfully directed to MPEP § 706.02(I)(2)(II), which states:

Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, ***if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.***

MPEP § 706.02(I)(2)(II) (emphasis added).

In accordance with MPEP § 702.06(I)(2)(II), the statement made above is sufficient to establish common ownership/assignment. For at least these reasons, claims 4, 6, 10, 13, and 65 are allowable over Larcheveque.

The Applicant argued against the Examiner's § 103(a) rejections in its February 29, 2008 Response. *See, e.g., Response, 02/29/2008, at 19-22.* While the Examiner's assertion that claims 4, 6, 10, 13, and 65 are unpatentable under 35 U.S.C. §103(a) is improper given the common ownership/assignment of the cited art and the present application, the Examiner's Official Notice assertions are not supported. The Examiner argues:

Larcheveque does not explicitly disclose the menu being a tool bar wherein users can activate a command tool. Official Notice is taken that menus in a tool bar format wherein users can activate a command tool are well known in the art. It would have been obvious to an artisan at the time of the invention to incorporate a tool bar format to the method of Larcheveque in order to provide users with an implementation preference.

...

Larcheveque does not explicitly disclose discovering a solution identifier in the data file, computing a special name from the solution

identifier, and discovering the solution using the solution name. Official Notice is taken that having an identifier and looking up the name from a look up table . . . is well known in the art.

...

Larcheveque does not explicitly disclose the presentation application being written in XSLT. Official Notice is taken that presentation applications being written in XSLT is well known in the art.

...

Larcheveque does not explicitly disclose it being written in XHTML. Official Notice is taken that using XHTML is well known in the art. It would have been obvious to an artisan at the time of the invention to incorporate XHTML to the method of Larcheveque

Office Action, 05/30/2008, at pp. 6-8.

The Applicant respectfully traverses the Examiner's assertion that the "noticed facts" are common knowledge or well-known in the art. The Applicant notes that the language labeled as "noticed facts," *see supra*, by the Examiner should be considered in the context of the claims. Accordingly, the Applicant respectfully requests that the Examiner provide documentary evidence to support these assertions of Official Notice and rejections.

Conclusion

This Amendment and Response fully responds to the Final Office Action mailed on May 30, 2008. It is recognized that the Office Action may contain arguments and rejections that are not directly addressed by this Amendment and Response due to the fact that they are rendered moot in light of the preceding arguments in favor of patentability. Hence, the failure, if any, of this Amendment and Response to directly address an argument raised by the Examiner should not be interpreted as reflecting the Applicant's belief that such argument has merit. Furthermore, the claims of the present application may include other elements, not discussed in this Amendment and Response, which are

not shown, taught, or otherwise suggested by the art of record. Accordingly, the preceding arguments in favor of patentability are advanced without prejudice to other bases of patentability.

In view of the above amendment and remarks it is submitted that the claims are patentably distinct over the prior art and that all the rejections to the claims have been overcome. Reconsideration and reexamination of the present application is requested. Based on the foregoing, applicants respectfully request that the pending claims be allowed, and that a timely Notice of Allowance be issued in this case. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the applicants' attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee that is not covered by an enclosed check please charge any deficiency to Deposit Account No. 50-0463.

Respectfully submitted,

Microsoft Corporation

Date: October 30, 2008

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I hereby certify that this correspondence is being electronically deposited with the USPTO via EFS-Web on the date shown below:

October 30, 2008
Date

/Noemi Tovar/
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